

ESTTA Tracking number: **ESTTA725508**

Filing date: **02/08/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Theory LLC		
Entity	limited liability company	Citizenship	New York
Address	38 Gansevoort Street New York, NY 10014 UNITED STATES		

Attorney information	Bret J. Danow Katten Muchin Rosenman LLP 575 Madison Avenue New York, NY 10022 UNITED STATES bret.danow@kattenlaw.com Phone:212-940-8800
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Applicant Information

Application No	86686136	Publication date	02/02/2016
Opposition Filing Date	02/08/2016	Opposition Period Ends	03/03/2016
Applicant	Shenzhen Ruijin Trade Co., Ltd. West Gate, 3/F, Block 7 Shenzhen, Guangdong, CHINA		

Goods/Services Affected by Opposition

Class 009. First Use: 2015/04/19 First Use In Commerce: 2015/04/19 All goods and services in the class are opposed, namely: Telephone apparatus; Electric batteries; Mobile telephones; Protective covers and cases for cell phones and telephones; Earphones; Battery chargers; Cabinets for loudspeakers; Headphones; Carrying cases specially adapted for pocket calculators; Computer peripheral devices; Bags adapted for laptops; Radiotelephony sets; Sleeves for laptops

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2802700	Application Date	01/18/1999
Registration Date	01/06/2004	Foreign Priority Date	NONE
Word Mark	THEORY		


Design Mark	THEORY
Description of Mark	NONE
Goods/Services	<p>Class 018. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 LEATHER GOODS, namely, BELTS, HANDBAGS,[KEY CASES, WALLETs,] TOTE BAGS, [COSMETIC BAGS SOLD EMPTY,] BACKPACKS, [FANNY PACKS, DIARY AND ADDRESS BOOK COVERS, AND LUGGAGE; AND UMBRELLAS]</p> <p>Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 WEARING APPAREL, namely, BELTS, [SLEEPWEAR,] [BATHING SUITS,] [STOCKINGS, LINGERIE, UNDERWEAR,] WRAPS, HATS, GLOVES AND FOOTWEAR</p> <p>Class 035. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 RETAIL STORE SERVICES IN THE FIELDS OF APPAREL, FOOTWEAR, BAGS [AND LUGGAGE AND WATCHES AND JEWELRY]</p>

U.S. Registration No.	3490184	Application Date	12/29/2004
Registration Date	08/19/2008	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark	THEORY		
Description of Mark	NONE		


Goods/Services	Class 009. First use: First Use: 2008/04/24 First Use In Commerce: 2008/04/24 EYEGLASSES, EYEGLOSS FRAMES and SUNGLASSES
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U.S. Application No.	85871512	Application Date	03/08/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 Wallets, identification holders, namely, identification card cases, luggage, carry-all bags, key cases, duffle bags, business card cases, credit card cases, cosmetic bags sold empty		

U.S. Registration No.	2067427	Application Date	10/08/1993
Registration Date	06/03/1997	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/08/17 First Use In Commerce: 1996/08/17 sweaters		

U.S. Registration No.	2338012	Application Date	02/03/1999
Registration Date	04/04/2000	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 WEARING APPAREL, NAMELY T-SHIRTS, TOPS, SHORTS, PANTS, SKIRTS, BLOUSES, DRESSES, EVENING GOWNS, JACKETS, COATS, SUITS, VESTS, SOCKS, SCARVES AND CAPS
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U.S. Registration No.	3388829	Application Date	06/24/2005
Registration Date	02/26/2008	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2005/01/31 First Use In Commerce: 2005/01/31 lip balm		

U.S. Registration No.	4088514	Application Date	11/13/2009
Registration Date	01/17/2012	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2003/01/01 First Use In Commerce: 2003/01/01 UMBRELLAS Class 025. First use: First Use: 2006/05/01 First Use In Commerce: 2006/05/01 WEARING APPAREL, NAMELY, BATHING SUITS		

Attachments	75980638#TMSN.png(bytes) 78539450#TMSN.png(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/BJD/
Name	Bret J. Danow
Date	02/08/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Shenzhen Ruijin Trade Co., Ltd.
Serial No.: 86/686,136
Filing Date: July 8, 2015
Mark: CASE THEORY & Design

Published in the Official Gazette on February 2, 2016

Theory LLC,)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
Shenzhen Ruijin Trade Co., Ltd.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Theory LLC (“Opposer”), a limited liability company organized and existing under the laws of the State of New York, having an address at 38 Gansevoort Street, New York, New York 10014, believes that it would be damaged by registration of the mark CASE THEORY & Design (“Applicant’s Mark”) as applied for by Shenzhen Ruijin Trade Co., Ltd. (the “Applicant”) in U.S. Use-Based Trademark Application Serial No. 86/686,136 (the “Application”). Accordingly, Opposer hereby opposes registration of Applicant’s Mark and alleges as follows:

1. Opposer is a leading designer, manufacturer, seller and retailer of a wide variety of consumer products ranging from clothing to accessories, and including bags. For over fifteen years, Opposer has advertised, promoted and sold its products under its widely-recognized THEORY mark that is the subject of many U.S. trademark applications and registrations owned by Opposer, including the following:

<u>Reg. / App. No.</u>	<u>Mark</u>	<u>Class(es)</u>	<u>Issuance/Filing Date</u>
2,802,700	THEORY	18, 25, 35	January 6, 2004
3,490,184	THEORY	9	August 19, 2008
85/871,512	THEORY	18	March 8, 2013
2,067,427	THEORY	25	June 3, 1997
2,338,012	THEORY	25	April 4, 2000
3,388,829	THEORY	3	February 26, 2008
4,088,514	THEORY	18, 25	January 17, 2012

2. Opposer's applications and registrations, several of which are incontestable, are valid, subsisting, and in full force and effect, and are collectively referred to herein as the "THEORY Marks." Opposer has also developed substantial common law rights in and to the THEORY Marks.

3. Opposer's products, all of which bear Opposer's federally registered THEORY Marks, are distributed domestically and internationally through various distribution channels, including: major department stores, THEORY branded retail stores, and via the Internet through Opposer's website located at www.Theory.com.

4. Since Opposer's initial use of the THEORY Marks in 1996, Opposer has continuously used, advertised, promoted and offered Opposer's various products bearing the THEORY Marks to the public, with the result that members of the relevant consuming public have come to know and recognize the THEORY Marks and associate them uniquely with Opposer. Opposer has acquired substantial goodwill and secondary meaning in each and all of its THEORY Marks.

5. On July 8, 2015, long after Opposer adopted and began using the THEORY Marks in commerce, Applicant filed the Application seeking registration of the Applicant's Mark in connection with "Protective covers and cases for cell phones and telephones," "Bags adapted for laptops," and "Sleeves for laptops," as well as other goods in International Class 009 ("Applicant's Goods").

6. The filing dates for each and all of the THEORY Marks pre-date the filing date of the Application and the date of first use claimed in the Application.

7. Applicant's Mark depicted in the Application incorporates the THEORY Marks in their entirety.

8. Applicant's Goods are at least substantially related to the products offered and sold by Opposer under the THEORY Marks.

9. The combination of the terms "Case" and "Theory" in Applicant's Mark gives the impression that Applicant's products are somehow a different version of Opposer's products or are somehow authorized or licensed by Opposer.

10. Applicant's Mark depicted in the Application so resembles Opposer's THEORY Marks in sight, sound, meaning and commercial impression as to be likely to cause confusion, mistake or deception by causing the public to believe that Applicant's Goods originate from, or are otherwise sponsored or endorsed by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damage to Opposer and the public within the meaning of 15 U.S.C. § 1063(a).

11. Additionally, because Applicant's Mark is a close approximation of Opposer's widely-recognized THEORY Marks, it creates a false impression that Applicant's Mark is somehow connected with Opposer's THEORY Marks when it is not. In fact, Opposer has previously sold products under both co-branded and composite marks that combined Opposer's THEORY Marks with an additional word element, increasing the likelihood that the public will

presume a connection between Applicant's Mark and Opposer's THEORY Marks. Accordingly, Opposer will be damaged by registration of the Application under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because Applicant's use of Applicant's Mark falsely suggests a connection between Applicant and Opposer, to the damage of Opposer under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark, and respectfully requests that this opposition be sustained and registration of Applicant's Mark be denied.

Dated: February 8, 2016

Respectfully submitted,



Bret J. Danow
KATTEN MUCHIN ROSENMAN LLP
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CERTIFICATE OF SERVICE

I hereby certify that, on this 8th day of February, 2016, I caused a true and correct copy of the Notice of Opposition against Application Serial No. 86/686,136 to be served upon Applicant's attorney of record via U.S. Mail at the following address:

Charles Ho
Barron & Young Intellectual Property Ltd.
P.O. Box 1484, General Post Office
Hong Kong



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